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SMART & BIGGAR

Intellectual Property & Technology Law

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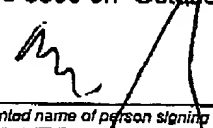
OCT 21 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/825,412
Applicant : Grant HOOD et al.
Filed : April 3, 2001
TC/A.U. : 2143
Examiner : David Wiley

Confirmation No.: 1647

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Sir:

The applicant respectfully requests pre-appeal brief review of the Examiner's final action mailed April 21, 2005. A Notice of Appeal is being filed herewith.

Claims 1 to 20 are pending.

Claims 1 to 14, and 16 to 20 remain rejected under 35 USC 103 as obvious in view of U.S. Patent Publication 2002/0073343 to Ziskind et al. (hereinafter "Ziskind") and U.S. Patent No. 6,665,389 to Haste (hereinafter "Haste").

As set out in the applicants' response to the first Office Action, in order to maintain a rejection under 35 USC 103, the Examiner must establish 1) presence of all the claim limitations in the prior art; 2) a motivation to modify or combine the elements in the prior art to arrive at the claimed invention; and 3) a likelihood of success.

The Examiner continues to take the position that pending claims are obvious in view of Ziskind and Haste. Careful review of Ziskind and Haste, however, reveal that neither Ziskind nor Haste disclose all of the elements in the currently pending claims (and in particular independent claims 1, 12 and 17), nor provide a motivation to modify or

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combine disclosed elements to arrive at the claimed invention. The Examiner has thus failed to establish a prima facie case of obviousness.

Specifically as claimed in claim 1,

Claim 1: (original) A method of facilitating exchange of messages at a computerized message exchange system, comprising:

- storing a first plurality of greetings at said system, each of said first plurality of greetings associated with users of a first introduction service provider;
- storing a second plurality of greetings at said server, each of said second plurality of greetings associated with a user of an introduction service provider, different from said first introduction service provider;
- allowing users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

Thus, as claimed, messages associated with users of two introduction service providers are stored and pooled so that users of at least one of the introduction service providers is provided access to selected greetings from users of the second introduction service provider. The selection is based on criteria associated with an originator of the second greetings and criteria set by the first introduction service provider.

As previously pointed out, Ziskind, however, is directed to a system allowing exchange of instant Internet messages. Instant messaging serves a fundamentally different purpose than introduction services, the subject of the present application. Instant messaging is designed to allow individuals, regardless of their specific interest, to communicate with each other. Thus, allowing users of one instant messaging service access to users of another is consistent with the underlying purpose of instant messaging, and is in principal no different than allowing subscribers of different phone companies to communicate with each other. As detailed in the background of the present application, introduction services are designed to introduce specific persons sharing a common interest, for, for example, social or dating purposes. As such, introduction service providers typically operate closed systems that only allow limited access between subscribers. A person of ordinary skill would thus have no motivation to use instant

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messaging systems and modify them to arrive at an introduction service, as suggested by the Examiner.

More fundamentally, however, even if Ziskind and Haste were combined, a person of ordinary skill would not arrive at the claimed invention, as neither Ziskind nor Haste disclose all of the elements of independent claims 1, 12 or 17.

As claimed in claim 1,

“users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.”

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second greetings, and criteria set by the first service provider. In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service provider include the gender, age and interest of users of the second service provider.

This is neither disclosed nor suggested by Ziskind or Haste.

In response to this argument, the Examiner refers to paragraph [0032] of Ziskind. Paragraph [0032] merely discloses the format of login data exchanged in Ziskind.

As noted in paragraph [0032] of Ziskind

[0032] Referring to FIG. 2, the method of the present invention includes the steps as follows. A user of an affiliate Web site logs into that site's Web services, step 10, with the user's client computer, creating a connection between the Internet and the client computer from which the user can invoke the Bantu Messenger. The

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affiliate user launches the Bantu Messenger by clicking on a link. Upon launching the Bantu Messenger, a login request is made to the Bantu Web server via a document.form.submit function which is located on the affiliate site. This function submits a hidden form to Bantu.com requesting Bantu messenger services and includes customization information, such as default language. Bantu in turn queries a senduser script located on the affiliate Web server. The exact URL for this script is supplied to the messenger service provider by the affiliate site. In addition, the senduser script can also be protected by IP block and by a username and password. The affiliate database is searched for the user's id and password. An XML formatted data packet is returned to the Bantu Web server with verification information 12. The XML data packet of this preferred embodiment contains the following fields:

...
Language 3 4 = Language 4 5 = Language 5 6 = Language 6 ContactEmailAddress
A valid email address (for contact purposes) (max length 200 characters).
[optional] ContactUserPref Single characters of ether B, N, or A Current Values: B
= contact via. bantu.com mail A = contact via. contact e-mail Address N = never
contact LocationZipCode User's zip code in the format of ##### or #####
Only for U.S. zipcodes. [optional] LocationCity User's city (max length 50
characters). [optional] LocationState User's state (max length 50 characters).
[optional] LocationCountry User's country (2 char ISO country code). [optional]
gender User's gender (single char of either M or F or X). Use value "X" if gender is
unknown, birthDate User's birth date in MM/DD/YYYY format. [optional]
birthYear User's birth year (4 digit year). listingInUserDirectory **Public directory
list flag (numeric 1 or 0). Set to "1" if the user should appear in listings of
users who are online, or set to "0" if this is not desired.** (Emphasis Added)

Ziskind thus alludes to the possibility of having a directory, but goes no further. As previously pointed out, the present application involves far more than a mere directory.

In the final action mailed April 21, the Examiner goes so far as to admit that the claim elements are not in the prior art. Nevertheless, relying on paragraph [0032] of Ziskind, the Examiner reasons "all of these fields are included for all service providers and thereby give motivation in order to search for a selected sub-set of users of other service providers. This gives proper motivation to find other systems which search for users based on selected criteria eventually finding the system of Haste and its interactive Internet based dating service providing a search service including age, location, physical characteristics, interests and lifestyles (see FIG. 1C)" (emphasis added). So, using the Examiner's reasoning, the mere presence of fields that could be used for filtering would eventually lead a person of ordinary skill to arrive at the missing limitation allowing users associated with

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the first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider.

This, it is submitted, is simply not the test for obviousness under 35 USC 103. To establish a prima facie case, all claim elements must first be found in the art, and there must be a motivation to combine/modify to arrive at the invention. The mere presence of a subset of the elements in the art, and knowledge of the applicants' invention is simply insufficient to conclude that a person of ordinary skill would arrive at the remaining claim elements and the invention. Any such, the conclusion reached by Examiner does not appear to be based on the cited art but instead appears to be made with impermissible hindsight. Reversal of the rejection is therefore required.

In view of the foregoing, favourable reconsideration of the Final Action and claims 1 to 20 are respectfully requested.

Respectfully submitted,

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		Art Unit 2143	Examiner Joseph E. AVELLINO	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.				
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